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10/006,785	11/09/2001	Todd A. Merritt	500345.02	1320

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EXAMINER

TRAN, DENISE

ART UNIT

PAPER NUMBER

2186

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PS

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/006,785	MERRITT, TODD A.	
Examiner	Art Unit		
Denise Tran	2186		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 April 2002.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-78 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1-53 is/are allowed.

6) Claim(s) 54-78 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

1. claims 1-78 are presented for examination.
  
2. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.
  
3. The preliminary amendment does not meet 1.17 (c) which requires an explanation of the support in the disclosure for the new added claims.
  
4. The original patent 5,983,314 has been surrendered and submitted in the application.
  
5. Claim 73 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 17. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
  
6. Claims 1-53 are allowable over the prior art of record.

7. Claims 54-85 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

8. Applicant's claims 60-63 and 64-65 attempt to improperly recapture broad subject matter original claimed in claims 37-40 and 41-42, respectively, that was surrendered in the application 08/898,177 (paper # 6) for the patent 5,983,314 upon which the present reissue is based. The scope of the original filed claims 37 and 41 in the application 08/898,177 correspond to the scope of the original filed claim 1. The limitations of the original claim 4 includes "wherein the data coder comprises:

a data mask register including the data mask control terminal, the data mask register receiving the data mask control signal on the data mask control terminal and a periodic clock signal on a clock input terminal, the register generating an output signal

responsive to a predetermined portion of the clock signal after the data mask control signal becomes active; and

a data output register coupled to the data mask register and including the data input terminals and the data read output terminals, the data coder forcing the data read output signals to have the predetermined values responsive to the data output signal from the data mask register”

Claims 37-42 did not have the limitations of the original filed claim 4 and they were surrendered in the application 08/898,177 (paper # 6) for the patent 5,983,314. The original filed claim 1 was surrendered in the application 08/898,177 (paper # 5) and the issued claim 1 was amended to combine the limitations of the original filed claims 1 and 4 for the patent 5,983,314.

9. Applicant's claims 66-68 attempt to improperly recapture of broad subject matter original claimed in claims 1-3, respectively, that was surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The original filed claim 1 was surrendered in the application 08/898,177 (paper # 5) and the issued claim 1 was amended to combine the limitations of the original filed claims 1 and 4 for the patent 5,983,314. The limitations of the original claim 4, “wherein the data coder comprises:

a data mask register including the data mask control terminal, the data mask register receiving the data mask control signal on the data mask control terminal and a periodic clock signal on a clock input terminal, the register generating an output signal

responsive to a predetermined portion of the clock signal after the data mask control signal becomes active; and

a data output register coupled to the data mask register and including the data input terminals and the data read output terminals, the data coder forcing the data read output signals to have the predetermined values responsive to the data output signal from the data mask register."

Applicant's claims 66-68 do not include all the limitations of the original filed claim 4 above.

10. Applicant's claim 69 attempts to improperly recapture of broad subject matter original claimed in claim 8 that was surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The original filed claims 1 and 8 were surrendered in the application 08/898,177 (paper # 5) and the issued claim 7 was amended to combine the limitations of the original filed claims 1, 8 and 9 and for the patent 5,983,314. The limitations of the original filed claim 9 includes "wherein the output stage comprises a first switch coupled between a first voltage node and the data output terminal;

a second switch coupled between a second voltage node and the data output terminal; and

wherein the logic circuit closes the first switch responsive to one of the data read signals having the first predetermined logic level, opens the first switch responsive to the data read signal having other than the first predetermined logic level, closes the

second switch responsive to the other of the data read signals having the second predetermined logic level, and opens the second switch responsive to the data read signal having other than the second predetermined logic level."

Applicant's claim 69 does not include all the limitations of the original filed claim 9.

11. Applicant's claims 70-72 attempt to improper recapture of broad subject matter original claims 19-21, respectively that was surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The original filed claim 19 was surrendered in the application 08/898,177 (paper # 5) and the issued claim 17 was amended to combine the limitations of the original filed claims 19 and 22 and for the patent 5,983,314. The limitations of the original claim 22, "wherein the data coder comprises:

a data mask register including the data mask control terminal, the data mask register receiving the data mask control signal on the data mask control terminal and a periodic clock signal on a clock input terminal, the register generating an output signal responsive to a predetermined portion of the clock signal after the data mask control signal becomes active; and

a data output register coupled to the data mask register and including the data input terminals and the data read output terminals, the data coder forcing the data read output signals to have the predetermined values responsive to the data output signal from the data mask register."

Applicant's claims 70-72 do not include all the limitations of the original filed claim 22.

12. Applicant's claim 73 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Applicant's claim 74 attempts to improperly recapture of broad subject matter original claimed in claim 26 that was surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The original filed claims 19 and 26 were surrendered in the application 08/898,177 (paper # 5) and the issued claim 23 was amended to combine the limitations of the original filed claims 19, 26 and 27 and for the patent 5,983,314. The limitations of claim 26 "wherein the output stage comprises a logic circuit that causes the output data bit to have a first logic level responsive to one of the data read output signals having a first predetermined logic level, that causes the output data bit to have a second logic level responsive to the other of the data read output signals having a second predetermined logic level, and that causes the data bit line to have the relatively high impedance responsive to both of the read output signals having other than the first and second predetermined logic levels," and

The limitations of the original claim 27 includes "wherein the output stage comprises a first switch coupled between a first voltage node and the output data bit;

a second switch coupled between a second voltage node and the output data bit; and

wherein the logic circuit closes the first switch responsive to one of the data read signals having the first predetermined logic level, opens the first switch responsive to the one data read signal having other than the first predetermined logic level, closes the second switch responsive to the other of the data read signals having the second predetermined logic level, and opens the second switch responsive to the other data read signal having other than the second predetermined logic level."

Applicant's claim 74 does not include all the limitations of claim 27.

14. Applicant's claims 75-77 attempt to improperly recapture of broad subject matter of the original claimed in claims 28-30, respectively that was surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The issued claim 24 was amended to combine the limitations of the original filed claims 28 and 31 and the original filed claim 28 was surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314. The limitations of the original filed claim 31 includes "wherein the data coder comprises:

a data mask register including the data mask control terminal, the data mask register receiving the data mask control signal on the data mask control terminal and a periodic clock signal on a clock input terminal, the register generating an output signal responsive to a predetermined portion of the clock signal after the data mask control signal becomes active; and

a data output register coupled to the data mask register and including the data input terminals and the data read output terminals, the data coder forcing the data read output signals to have the predetermined values responsive to the data output signal from the data mask register."

Applicant's claims 75-77 does not include all the limitations of the original filed claim 31 above.

15. Applicant's claim 78 attempts to improperly recapture of broad subject matter original claimed in claim 35 that was surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The issued claim 30 was amended to combine the limitations of the original filed claims 28, 35 and 36; and the original filed claims 28 and 35 were surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314. The limitations of the original filed claim 36 includes "wherein the output stage comprises a first switch coupled between a first voltage node and the output data bit;

a second switch coupled between a second voltage node and the output data bit;  
and

wherein the logic circuit closes the first switch responsive to one of the data read signals having the first predetermined logic level, opens the first switch responsive to the one data read signal having other than the first predetermined logic level, closes the second switch responsive to the other of the data read signals having the second

predetermined logic level, and opens the second switch responsive to the other data read signal having other than the second predetermined logic level."

Applicant's claim 78 does not include all the limitations of the original filed claim 36.

16. Applicant's claims 54-57 are attempt to improper recapture of broad claimed subject matter surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The scope of the original filed claims 37 and 41 in the application 08/898,177 correspond to the scope of the original filed claim 1. The limitations of the original filed claim 4 includes "wherein the data coder comprises:

a data mask register including the data mask control terminal, the data mask register receiving the data mask control signal on the data mask control terminal and a periodic clock signal on a clock input terminal, the register generating an output signal responsive to a predetermined portion of the clock signal after the data mask control signal becomes active; and

a data output register coupled to the data mask register and including the data input terminals and the data read output terminals, the data coder forcing the data read output signals to have the predetermined values responsive to the data output signal from the data mask register."

Claims 37-42 did not have the limitations of the original filed claim 4 and they were surrendered in the application 08/898,177 (paper # 6) for the patent 5,983,314.

The original filed claim 1 was surrendered in the application 08/898,177 (paper # 5) and the issued claim 1 was amended to combine the limitations of the original filed claims 1 and 4 for the patent 5,983,314. Applicant's claims 54-57 do not include all the limitations of the original filed claim 4 above.

17. Applicant's claims 58-59 are attempt to improper recapture of broad claimed subject matter surrendered in the application 08/898,177 (paper # 5) for the patent 5,983,314 upon which the present reissue is based. The scope of the original filed claims 37 and 41 in the application 08/898,177 correspond to the scope of the original filed claim 1.

The limitations of claim 8 "wherein the output stage comprises a logic circuit that causes the data output signal to have a first logic level responsive to one of the data read output signals having a first predetermined logic level, that causes the data output signal to have a second logic level responsive to the other of the data read output signals having a second predetermined logic level, and that causes the data output terminal to have the relatively high impedance responsive to both of the read output signals having other than the first and second predetermined logic levels," and

The limitations of the original claim 9 includes "wherein the output stage comprises a first switch coupled between a first voltage node and the data output terminal;

a second switch coupled between a second voltage node and the data output terminal; and

wherein the logic circuit closes the first switch responsive to one of the data read signals having the first predetermined logic level, opens the first switch responsive to the data read signal having other than the first predetermined logic level, closes the second switch responsive to the other of the data read signals having the second predetermined logic level, and opens the second switch responsive to the data read signal having other than the second predetermined logic level."

Claims 37-42 did not have the limitations of the original filed claims 8 and 9 and they were surrendered in the application 08/898,177 (paper # 6) for the patent 5,983,314. The original filed claim 1 was surrendered in the application 08/898,177 (paper # 5) and the issued claim 1 was amended to combine the limitations of the original filed claims 1, 8, and 9 for the patent 5,983,314. Applicant's claims 58-59 do not include all the limitations of the original filed claims 8 and 9 above.

18. Figure s 2-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Kwon (5414379);
- b) Chnnaswamy et al. (5235693);

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- c) Miyamoto (5394366);
- d) Miller et al. (5787457) ;
- e) Adams et al. (5381540) ;
- f) Pinkham et al. (5661692) ;
- g) baba et al. (4899310) ; and
- h) Shibuya (5383154).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Denise Tran whose telephone number is (703) 305-9823. The examiner can normally be reached on Monday, Wednesday, and an alternate Thursday from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (703) 305-3821. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 7467-239 for Official communications, (703) 746-7240 for Non Official communications, and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



D.T.  
September 26, 2002